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From: intelprop@katona.net  
Sent: Monday, April 23, 2001 9:01 PM  
To: scpcomments@uspto.gov  
Subject: The "harmonization" meeting in Geneva

I have several comments in connection with the proposed "harmonization" meeting.

(1) There was a recent activity in connection with the wrongly named Patent Law Treaty. It is a largely useless effort, with much verbiage, but very little substance, and even less useful substance. Let that one run its course, before embarking on this more ambitious project.

(2) The structure of a most generalized practically meaningless treaty text proposal, wherein the substance is hidden in regulations which are written (i.e. imposed) by an arbitrary process by officials who are government employees, rather than elected representatives, is most reprehensible. As is this process of soliciting comments which are not released to the public by the PTO officials, but are made only "available for local inspection."

(3) The ONLY subjects to which the US delegation should speak, are those aspects that are for some strange reason lumped into a "substantive" group, whereas they should be considered as a part of the procedural group. These all relate to harmonizing certain practices which will allow filing the same application in all signatory countries without no need for the current ridiculous and extensive and costly adaptation procedures. These are the only aspects of patent practice and international diversity that should be currently addressed and harmonized, and are the following:

(a) make the number of claims that are allowable without payment of additional fees, uniform.

(b) make the question of multiple dependencies (without extra fees) uniform.

(c) make the claim format (e.g. 2-part vs. one part claims) uniform.

(d) make the question (?) of requiring reference numerals in claims uniform.

(e) make requirements uniform that claims should contain technical features only, but no economic features.

(f) make uniform requirements how close additional independent claims need to be.

one (g) make uniform unity conditions for retention of kinds of claims in application (product, process to make, process to use, "use" claims, etc.) N.b. the USPTO has resisted for many years adoption of the international unity standard from PCT.

(h) make functional claiming uniformly acceptable.

(i) uniform provisions for allowing functional language in claims.

(j) make possibility of amending claims broadly available during pendency in all countries.

Now these are topics that uniformly deserve to be addressed, that would make international patent practice easier and simpler, instead of trying to turn the really substantive patent laws upside down. Patent offices and patent office employees should deal with subjects like these which deal with patent practice, and stay away from those topics with regard to which most of the patent office officials have no competence.

(4) I shall address only one aspect of the subjects listed in the call for comments, which,

as I mentioned above, officials of all patent offices should stay away from. That single subject is the steady drumbeat of overseas patent agents attempting to have the US eliminate the *best mode* disclosure requirement from 35 USC 112 (p.1). Here is a quote from an overseas professional organization which attempts to justify the absence of a best mode disclosure requirement:

"We widely believe that the requirement for an inventor to disclose the *best mode* known to him is unduly onerous and unfair on inventors and their employers ... , it should be remembered that patents are only one member of the family of intellectual property rights which also includes *confidential information*, particularly *know how*. It is argued that provided an inventor has given a sufficiently clear and complete disclosure [ how can that be without disclosure of the best mode?] for a skilled worker in the relevant art to reproduce his invention across substantially the entire width of a claim without undue experimentation, the inventor should not be required to divulge any further technical information known to him at the time of filing which enables him to derive the best results from the invention ... it is submitted that to do so actually runs contrary to an underlying objective of the patent system which is to encourage the disclosure of inventions [this, of course, is asinine, how does concealment promote disclosure?]. We are aware of inventors who question the value of filing patent applications at all if they are required to disclose their best embodiment [that's just too bad! This eating your cake and keeping it too attitude is alien to our patent system].

Another danger of permitting concealment of the best mode, is that after expiration of a generic patent, the former patentee might secure for itself another period of exclusivity by filing a narrower patent application claiming the best mode that was kept secret until then.

It was a major blunder by the "brainless trust" of our PTO officials, to forget themselves and to promise at WIPO last November, to do away in the US with the best mode requirement (along with the first-to-invent principle enshrined in our laws) within a year (and then come back home and deny having done so)!

Sincerely, Gabriel P. Katona  
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